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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,489	12/06/2001	Roger O. Williams	514542001000	3230
25226	7590	04/14/2005	EXAMINER	
MORRISON & FOERSTER LLP			ALI, MOHAMMAD M	
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3744

DATE MAILED: 04/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/006,489

Applicant(s)

WILLIAMS ET AL.

Examiner

Mohammad Ali

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-100 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22, 23, 29-31, 48, 57 and 58 is/are allowed.
- 6) ☒ Claim(s) 1-21, 24-28, 32-47, 49-56 and 59-100 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-4, 8-13, 15, 21, 25, 28, 32-34, 40, 59-60, 65-68 and 72, 74-76, 78, 81-85, 88, 95-96 and 99-100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giordano et al., (4,097,872). Giordano et al., disclose an apparatus for droplet aspirator comprising a throated structure having a nozzle/wind tunnel 10 mounted in a direction and defined therethrough an entrance 12 at a proximal end of the nozzle 10 and an exit port 14 at a distal end of the nozzle 10, wherein the throated structure further defines at least one channel in fluid communication with the nozzle 10 for receiving a flow of fluid such that the trajectory of a droplet entering the entrance 12 is alterable by the flow of fluid to a predetermined path as the droplet passes through the exit port 14 and a droplet generator/jet nozzle 38 for forming the droplet, being disposed proximally of the throated structure. See Fig 1, the abstract and column 5, lines 29-31. Giordano et al., disclose the invention substantially as claimed as stated above. However, Giordano et al., do not disclose a vertically mounted nozzle. To choose any particular mounting position of the nozzle is an obvious choice of the individual skilled in the art since there is no criticality or un expected result from it.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giordano et al. in view of Williams et al. (6,596,239). Giordano et al. disclose the invention substantially as claimed as stated above. However, Zeigler et al., do not disclose micro-droplets having a size 100 times smaller than the size of a droplet. Williams et al., teach the use of a micro-droplet (see abstract) having a size 100 times smaller than a size of the droplet. See column 8, lines 48-50 in an acoustically mediated fluid transfer methods and uses thereof for the purpose of droplet generation. Therefore, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify the apparatus of Giordano et al. in view of Williams et al., such that a system for producing micro-droplet with desired size could be provided in order to produce required droplet trajectory.

3. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giordano et al. in view of Nagano et al. (4,740,571). Giordano et al. disclose the invention substantially as claimed as stated above. However, Giordano et al. do not disclose a diameter range 1-3mm for the inlet port of the nozzle. Nagano et al., teach the use of a 1.5 mm inlet diameter of a nozzle for the purpose of desired nozzle action. See

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column 12, lines 39-42. Therefore, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify the apparatus of Giordano et al. in view of Nagano et al., such that a nozzle size having 1.5mm diameter inlet could be provided in order to produce desired nozzle action.

4. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giordano et al. in view of Matiaccio et al., (5,716,540). Giordano et al. disclose the invention substantially as claimed as stated above. However, Giordano et al. do not disclose a diameter range 0.025-1 mm for the outlet port of the nozzle. Matiaccio et al., teach the use of a 0.5- 1.2 mm outlet diameter of a nozzle for the purpose of desired nozzle action. See column 2, lines 57-62. Therefore, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify the apparatus of Giordano et al. in view of Matiaccio et al., such that a nozzle size having 0.5mm diameter outlet could be provided in order to produce desired nozzle action.

5. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giordano et al. in view of Skeath et al., (6,513,736). Giordano et al. disclose the invention substantially as claimed as stated above. However, Giordano et al. do not disclose a flow rate of 0.5-5 liters per minute. Skeath et al., teach the use of a flow rate of 5 liters per minute in an atomizing device for the purpose of producing droplets. See column 5, lines 55-57 and abstract. Therefore, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify the apparatus of Giordano et al. in view of Skeath et al., such that a flow rate of 5 liters per minute could be provided in order to produce droplets.

6. Claims 26, 27, 63 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giordano et al. in view of Kennedy (6,047,725). Giordano et al. disclose the invention substantially as claimed as stated above. However, Giordano et al. do not disclose different angles of droplet measured from the longitudinal axis. Kennedy teaches the use of various angles of droplets in a micro fluid circuit for the purpose of generating droplets with various trajectory angles. See column 6, lines 11-14. Therefore, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify the apparatus of Giordano et al. in view of Kennedy such that a various trajectory angles could provided in order to have desired trajectory angle of the droplets.

7. Claims 6-7, 14, 16-18, 35-36, 41-45, 61-62,86-87 and 89-94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giordano et al. in view of Jolliffe (6,586,731). Giordano et al. disclose the invention substantially as claimed as stated above. However, Giordano et al. do not disclose vacuum pump, capillary tube, and voltage source. Jolliffe teaches the use of a vacuum pump 30b, voltage source 20/21 and a capillary tube 16 in a high intensity ion source producing droplet trajectory for the purpose of altering trajectory of droplet. See Fig. 6. Therefore, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify the apparatus of Giordano et al. in view of Jolliffe such that a vacuum pump, a capillary tube and a voltage source could be provided in order to produce required

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droplet trajectory. Regarding claim 35 for choosing a glass slide for a target medium and claim 14 and 16-18 for choosing a shape of the cross-section of the nozzle are obvious choices of the individual skilled in the art since there is no criticality or unexpected result from it.

8. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giordano et al. in view of Jolliffe (6,586,731) as applied to claim 45 above and further in view of Pui et al., (6,764,720). Giordano et al., in view of Jolliffe disclose the invention substantially as claimed as stated above. However, Zeigler et al., in view of Jolliffe do not disclose a voltage source producing 7500 volts. Pui et al., teach the use of a voltage source, which produces 7500 volts in a nozzle system for the purpose of generating droplets/particles. See Fig. 6 and column 10, lines 37-40. Therefore, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify the apparatus of Giordano et al., in view of Jolliffe and further in view of Pui et al., such that a voltage source generating 7500 volts could be provided in order to generate droplets.

9. Claim 80 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giordano et al. in view of Zeigler et al., (5,759,961). Giordano et al. disclose the invention substantially as claimed as stated above. However, Giordano et al. do not disclose a gradual narrow passage with distal end of a nozzle. Zeigler et al., teach the use of a nozzle 26 with narrow distal end in a droplet trajectory system for the purpose of altering trajectory of droplet. See Fig. 1. Therefore, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify the

apparatus of Giordano et al. in view of Zeigler et al. such that a nozzle with narrow distal end could be provided in order to produce droplet trajectory.

10. Claims 47, 49-53, 55-56 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giordano et al. in view of Schultz et al. (6,633,031). Giordano et al. disclose the invention substantially as claimed as stated above. However, Giordano et al. do not disclose a plurality of nozzles with a plate having first and second surface. Schultz et al. teach the use of plurality of nozzles 110 with a plate having first and second surface producing droplet trajectory for the purpose of altering trajectory of droplet. See Fig. 3I and 4B. Schultz et al. also teach the use of well plate 154, wells and wells 152. See Fig. 5B. Therefore, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify the apparatus of Giordano et al. in view of Schultz et al. such that a plurality of nozzles with plate having first and second surface could be provided in order to produce droplet trajectory.

11. Claims 37, 39, 77 and 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giordano et al. in view of Schultz et al. (6,633,031). Giordano et al. disclose the invention substantially as claimed as stated above. However, Giordano et al. do not disclose a well plate. Schultz et al. teach the use of a well plate 154 producing droplet trajectory for the purpose of altering trajectory of droplet. See Fig. 5B. Therefore, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify the apparatus of Giordano et al. in view of Schultz et al. such that a plurality of nozzles with plate having first and second surface could be provided in order to produce required droplet trajectory.

12. Claims 38 and 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giordano et al. in view of Schultz et al. (6,633,031) as applied to claim 37 and 54 above and further in view of Hollinshead (5,942,387). Giordano et al. in view of Schultz et al., disclose the invention substantially as claimed as stated above. However, Giordano et al. in view of Schults et al., do not disclose a microtiter plate. Hollinshead teaches the use of a microliter plate in a wellplate for the purpose of droplet generation. Column 46, lines 43-44 and Fig.1. Therefore, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify the apparatus of Giordano et al. in view of Schultz et al. and further in view of Hollinshead such microtiter plate having 96 wells could be provided in order to generate droplets.

13. Claims 69 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giordano et al. in view of Quate et al., (4,697,195). Giordano et al. disclose the invention substantially as claimed as stated above. However, Giordano et al., do not disclose focus acoustic energy. Quate et al., teach the use of a focus acoustic energy in an ejector for the purpose of droplet generation. See column 1, lines 57-62. Therefore, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify the apparatus of Giordano et al. in view of Quate et al., such that focus acoustic energy could be provided in order to generate dropels.

14. Claim 71, 79 and 98 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giordano et al. in view of Schultz et al., as applied to claim 47 above and further in view of Quate et al., Giordano et al. in view of Schultz et al., disclose the invention substantially as claimed as stated above. However, Giordano et al., in view Schultz et

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al., do not disclose focus acoustic energy. Quate et al., teach the use of focus acoustic energy in an ejector for the purpose of generation of droplets. See column 1, lines 57-62. Therefore, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify the apparatus of Giordano et al. in view of Schultz et al. and further in view of Quate et al., such that focus acoustic energy could be provided in order to generate droplets.

Allowable Subject Matter

15. Claims 22-23, 29-31, 48 and 57-58 are allowed.

Response to Arguments

16. Applicant's arguments, see remarks and conclusion filed 03/15/05, with respect to the rejection(s) of claim(s) 1-73 under 102 and 103 rejections have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of having a new prior art after a new search.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad Ali whose telephone number is 703-308-5032. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Esquivel Denise can be reached on 703-308-2597. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mohammad M. Ali
April 11, 2005


WILLIAM TAPOLCAI
PRIMARY EXAMINER